In the Supreme Court of the United States

OCTOBER TERM, 1966

No. 363

IN THE MATTER OF THE APPLICATION OF
ARTHUR L. REESE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MEMORANDUM FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

The sole question presented is whether, under the circumstances of this case, the court below properly dismissed petitioner's appeal as untimely.

Upon petitioner's application for a patent on a "wear compensating die," the Examiner rejected each of petitioner's six claims, and petitioner appealed. On June 29, 1964, the Patent Office Board of Appeals reversed the rejection of claims 3, 4 and 6, but sustained the rejection of the remaining claims (Pet. App. 29–38). On July 24, within the thirty days provided under Patent Office Rule 197(b) (Pet. App. 2), petitioner filed a petition for reconsideration, contending that the Board had read the three claims which it allowed too narrowly and had overlooked

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certain considerations with respect to the three claims it rejected. On September 21, the Board granted the petition and reversed its prior rejection of claims 1, 2 and 5; however, it declined to deviate from its prior construction of claims 3, 4 and 6 (Pet. App. 39–41). Petitioner did not note an appeal within thirty days of this decision, but, on September 24, he filed a second petition for reconsideration. On October 16, the Board issued an opinion stating that "the petition has been granted to the extent that we have considered the same but is denied with respect to making any change in our opinion in the case or opinion on the first request for reconsideration" (R. 42; Pet. App. 44). On November 2, forty-two days after the decision on petitioner's first petition for reconsideration, petitioner noted an appeal to the Court of Customs and Patent Appeals, which dismissed the appeal as untimely under Patent Office Rule 304 (see Pet. App. B; 359 F. 2d 462).

Under 35 U.S.C. 142 (Pet. App. 1–2), a notice of appeal from the Board of Appeals to the Court of Customs and Patent Appeals must be filed in the Patent Office "within such time after the date of the decision appealed from, not less that sixty days, as the Commissioner appoints."[1] Pursuant to this mandate, the Commissioner of Patents had provided that "[t]he time for filing the notice and reasons of appeal * * * is sixty days from the date of the decision of the Board of Appeals * * *" (Rule 304; Pet. App. 3). If a

[1] The only statutory provision dealing with petitions for rehearing is 35 U.S.C. 7, which vests the Board of Appeals with "sole power to grant rehearings."

petition for rehearing is filed within thirty days of this decision, the time for noting an appeal "is extended to thirty days after action on the petition"[2] (*ibid.*). No rule expressly authorizes successive petitions for rehearing. Rule 197(b), however, provides that "[a]ny request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the *original decision,* unless that decision is so modified as to become, in effect, a new decision, *and the Board of Appeals so states*" (Pet. App. 2; emphasis supplied). Petitioner does not challenge the validity of either of these rules; he complains only of their application to the particular facts of this case.

In dismissing petitioner's appeal as untimely, the court correctly applied the Patent Office Rules. Petitioner's petition for reconsideration of the Board's original decision was timely filed. Accordingly, under Rule 304, he had thirty days from the date of the Board's action on that petition (September 21) to appeal to the Court of Customs and Patent Appeals. His notice of appeal was not filed within that period.

The period could not have been extended by the second petition for reconsideration. The Rules do not authorize the filing of such a petition except when, in its decision on the first petition, the Board has stated that it is issuing a "new decision". In this case, the Board in no way suggested that its decision of Sep-

[2] As this Rule is construed by the Patent Office, a dissatisfied petitioner may perfect an appeal within either thirty days from the denial of his petition for rehearing or sixty days from the original decision of the Board, whichever is longer.

tember 21 was "new". And its ruling on the three claims which were the subjects of petitioner's tardy appeal was the same as its ruling in the original decision. The fact that the Board "entertained" the second petition is immaterial. Rule 304 expressly provides that "[n]o petition for rehearing or reconsideration filed outside the time specified herein after such decision [thirty days], *nor any proceedings on such petition* shall operate to extend the period of sixty days hereinabove provided" (Pet. App. 3; emphasis supplied).

Essentially, petitioner's complaint is with the refusal of the court below to characterize the Board's September 21 decision as a "new decision".[3] But the Rules give the function of classifying "new" decisions only to the Board itself; this makes for simplicity and certainty in the application of the time limit on appeals. Even if the court below were authorized to denominate the Board's September 21 action as a "new decision", the question whether it should have done so turns on the peculiar facts of this case and does not warrant review by this Court.

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[3] Contrary to the inference drawn by petitioner from part of a sentence in a footnote to the court's opinion (Pet. App. 5, n. 1)—which he quotes out of context and without the court's italics and qualifying language (Pet. 7)—the court did not rule that an appeal would lie only from a decision rejecting patent claims. The Commissioner argued, as an alternate ground for dismissing the appeal, that the court was without jurisdiction to hear an appeal from a decision granting all of the disputed claims, but the court based its dismissal solely on the untimeliness point and did not reach this issue.

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

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